



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/292,887	04/16/1999	WARREN S. WILCOX	286052-002	4136

37509 7590 03/23/2004

DECHERT LLP  
P.O. BOX 10004  
PALO ALTO, CA 94303

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 03/23/2004

25

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/292,887

Applicant(s)

WILCOX ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 3 March 2004 has been entered.

---

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 23-32, 35-40 and 45-46 are rejected under 35 U.S.C. 103(a) as being obvious over Fernandez-Holmann.
4. Fernandez-Holmann teaches (independent claims 23, 36 and 45) a credit card incentive system, computerized method for providing credit card incentive payments, and a computer readable medium containing a method for providing credit card incentive payments, the method comprising: establishing a credit card account for a credit card holder having an investment account at a particular financial institution that can receive periodic equal-sized payments (col. 4 lines 35-36, col. 2 lines 29-33, col. 3 lines 17-19 and col. 4 lines 49-50); checking to determine if the credit card account is in good standing (col. 5 lines 29-38); accumulating, on a computer system, the total value of all purchases made by the card holder using the credit card during a period of time, and calculating, on a computer system, the investment benefit amount based on the accumulated value of all purchases, if the credit card account is in good standing, and transferring the investment benefit amount to the investment manager (col. 5 lines 52-63), as an extra payment (col. 6 lines 21-25 and col. 4 lines 20-28).

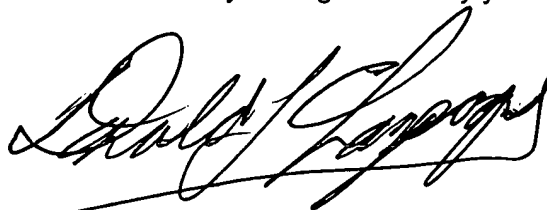
5. Fernandez-Holmann does not teach that the investment account is a home mortgage account, which reads on an installment loan account that requires a fixed number of periodic, equal-sized payments to retire the loan. Because home mortgages are the most common household investments, and therefore the incorporation of home mortgages would encourage use of the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add home mortgage accounts to the investment account teachings of Fernandez-Holmann.
6. Fernandez-Holmann does not teach determining if there is an outstanding balance on the credit card holder's installment loan/investment account. Because it is good practice to verify that a loan has not been paid off before making a payment, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determining if there is an outstanding balance on the credit card holder's installment loan/investment account.
7. The limitation *credit card issuer* computer system is an ownership limitation that is nonfunctional descriptive material, and was accordingly not given patentable weight. See MPEP 2106.IV.B.1(b), first paragraph.
8. Fernandez-Holmann also teaches at the citations given above claim 28. Fernandez-Holmann also teaches claims 31 and 39 (col. 6 line 17) and claim 40 (col. 5 lines 63-65).
9. Fernandez-Holmann does not teach (claims 24, 37 and 46) determining if the loan has been refinanced. This is obvious for the reason given in para. 6 above.
10. Fernandez-Holmann does not teach (claims 25, 26 and 27) that the benefit amount is transferred by wire and/or check. Because these are common instruments each useful in some circumstances, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add transfer of the benefit amount by wire and/or check to the teachings of Fernandez-Holmann.
11. Fernandez-Holmann does not teach (claims 29-32, 35 and 38) that the payment period is one year. Because some customers may prefer a longer period, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add one year to the periodic payment teachings of Fernandez-Holmann.
12. Claims 33, 34 and 41-44 are rejected under 35 U.S.C. 103(a) as being obvious over Fernandez-Holmann in view of Simpson. Fernandez-Holmann does not teach that the

Art Unit: 3622

benefit amount is based on the value of interest charged. Simpson teaches that the benefit amount is based on the value of interest charged (col. 1 lines 46-58). Because it would make the reference invention more attractive to some customers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Simpson to the teachings of Fernandez-Holmann.

**Conclusion**

13. **COPY of REFERENCES** - Applicant is entitled to receive a copy of every reference cited by the examiner (except at allowance; MPEP 707.05(a)). Applicant should contact the examiner if a completed form PTO-892 is enclosed, but the cited references are not.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
15. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne  
Examiner  
Art Unit 3622

17 March 2004